

REMARKS

Claims 1 and 2 are pending in this application. By this Amendment, claims 1 and 2 are amended. The amendments introduce no new matter. Claims 3 and 4 are canceled without prejudice to, or disclaimer of, the subject matter recited in those claims.

Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed below; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; (c) satisfy a requirement of form asserted in the previous Office Action; and (d) place the application in better form for Appeal, should an Appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the Final Rejection. Entry of the amendments is thus respectfully requested.

The Office Action, in paragraph 2, objects to claims 1-4 for certain informalities. Specifically, the Office Action indicates that the term "indication mark" is unclear when reference is made to the specification. Applicants amend claims 1 and 2 to obviate the objection. Withdrawal of the objection to claims 1 and 2 is respectfully requested.

The Office Action, in paragraph 3, rejects claims 1 and 2 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,239,373 to Tang et al. (hereinafter "Tang") in view of U.S. Patent No. 5,790,144 to Geaghan et al. (hereinafter "Geaghan"). The incorporation of the subject matter of now-canceled claims 3 and 4 respectively into claims 1 and 2 renders this rejection moot.

The Office Action, in paragraph 4, rejects claims 3 and 4 under 35 U.S.C. §103(a) as being unpatentable over Tang in view of Geaghan and further in view of U.S. Patent No.

6,554,434 to Sciammarella et al. (hereinafter " Sciammarella "). The cancellation of claims 3 and 4 renders this rejection moot as to those claims. To the extent, however, that the subject matter of claims 3 and 4 is incorporated respectively into claims 1 and 2, this rejection is respectfully traversed.

Tang teaches a video computational shared drawing space system comprising display units for displaying composite images, styluses for writing on the composite images, and a computer (Abstract). Tang indicates that a device used for detecting the position of the stylus can use visual, as emitted light by light emitting diodes (LEDs), resistive, electromagnetic or sonic signals, or alternatively that the computer, in association with the video camera, may be programmed to detect the position of the stylus (col. 2, lines 35-40). Tang makes no reference to, nor would Tang reasonably have suggested, at least a virtual screen that is set on the material mounting surface; an indication mark for setting the virtual screen and for being used by a user to operate a point on the virtual screen.

The Office Action concedes that Tang does not expressly disclose defining a working virtual surface by two arbitrary points to define a rectangular area. Rather, the Office Action relies on Geaghan in its disclosure of a touch-based input system where the user provides two arbitrary points to calibrate and define a rectangular area where coordinates are defined so that the input of the points can be indicated by the user. The Office Action concludes that it would have been obvious to combine the teachings of Tang and Geaghan to produce a touch screen input system or rectangular virtual screen is defined by two arbitrary points. With regard to the subject matter of claims 3 and 4 now respectively incorporated by amendment into claims 1 and 2, an optical filter which is removably provided in the photographing section and which enabled the photographing section to photograph only light emitted from the pointing mark, the Office Action concedes that a combination of Tang and Geaghan does not disclose such a limitation. Rather, the Office Action relies on Sciammarella as disclosing

a light pen system that provides infrared light to a camera section that has a filter for filtering out other wavelengths of light so that the position of the light pen can be determined. The Office Action then concludes that it would have been obvious to one of ordinary skill in the art to combine Sciammarella with Tang and Geaghan replacing a visible light pen with a light pen having a non-visible wavelength of light to remove a light that would normally be visible to a user when operating the pen and looking at the input surface. The analysis of the Office Action fails for at least the following reasons.

The subject matter of the pending claims as recited in claims 1 and 2 is directed to a material presentation device connecting at least two material presentation devices to each other. The recited device includes, among other features, a photographing section for photographing the material mounted on the material mounting surface, a virtual screen which is set on the material mounting surface, a pointing mark for setting the virtual screen and for being used by a user to operate a point on the virtual screen and an optical filter which is removably provided to the photographing section and which enables the photographing section to photograph only light emitted from the pointing mark. Further, the pending claims recite that when the user sets to arbitrary reference points by using the pointing mark on the material mounting surface, the photographing section photographs the two reference points, and coordinates on the virtual screen are generated by an image processing technique from a photographed image of the two arbitrary reference points photographed by the photographing section, so that the virtual screen is set to have a rectangular area based on the two arbitrary reference points.

The optical filter is removably provided such that when a camera image is obtained, the optical filter is removed from the photographing section, and the photographing section can photograph the material mounted on the material mounting surface. Alternatively, when the virtual screen is set to have a rectangular area on the material mounting surface based on

the two arbitrary reference points indicated by the pointing mark, the optical filter is provided in the photographing section. The photographing section can photograph the two arbitrary reference points and the image processing can be executed by using the photograph image of the two arbitrary reference points. Since the filter is removably provided to the photographing section, photographing of the material and detection of the pointing mark can be performed by only one photographing section. As such, it is unnecessary to provide a detecting device separately from the photographing section. It is equally unnecessary to provide separate photographing sections. Thus, the structure of the material presentation device is simplified.

Tang teaches an optical filter which enables the photographing section to photograph only light emitted from the pointing mark that is not removably provided to photographing section 12A and 12B. See, for example, Fig. 3 in which mark detecting devices 20A and 20B for detecting positions of marks 24A and 24B are provided separately from the photographing sections 12A and 12B. As shown in, for example, Fig. 17, a photographing section 70 is provided separately from photographing sections 12A and 12B so as to photograph material. However, the photographing section 70 cannot detect the positions of marks 24A and 24B. In Tang, therefore, it is necessary to provide the mark detecting devices 20A and 20B separately from the photographing sections 12A and 12B. Since photographing of the material and detection of the marks cannot be performed by only one photographing section, as is recited in the pending claims, Tang cannot reasonably be considered to teach such a feature.

In Geaghan, as discussed at, for example, col. 6, lines 39-58, a rectangular area is set on the touch screen based on the two arbitrary reference points indicated by a user, and a pointing operation is formed on the rectangular region. To any extent that Geaghan is even combinable with Tang, a conclusion that Applicants' do not concede, Geaghan does not have a photographing section and/or an optical filter as is positively recited, among other features,

in the pending claims for at least this reason, the combination of Geaghan and Tang neither teaches nor suggests the subject matter of the pending claims.

Reference to Sciammarella in, for example, Fig. 13 as showing an optical filter 7B which enables a photographing section 7 to photograph only light emitted from a mark 9A (infrared emitter) is provided to the photographing section 7. Any alleged optical filter 7B in Sciammarella is, however, secured in the photographing section 7. As such, the Sciammarella cannot reasonably be considered to teach an optical filter that is removably provided to the photographing section. As with Tang, because of this configuration, photographing of material and detection of a mark cannot be performed by only one photographing section. As such, any permissible combination of Sciammarella with Tang and Geaghan cannot reasonably be considered to teach, or have suggested, the subject matter of the pending claims.

Additionally, the conclusory statements regarding the obviousness of combining the references for the reasons noted are not enough to prove that there is a teaching, suggestion or motivation in the prior art to combine these references in the manner suggested by the Office Action. The Federal Circuit recently reaffirmed its prior holdings asserting that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, Appeal No. 04-1616, March 22, 2006 (Fed. Cir.) (quoting *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002), and *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)). This standard is not met by just pulling some minimal reference out of one of the references and presenting that, in a conclusory manner, as evidence.

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests

the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that the rejection of independent claims 1 and 2 is improper in view of at least MPEP §2143.01 because the Office Action lacks the required specific evidence of a teaching, suggestion or motivation in the prior art for one of ordinary skill to combine these references.

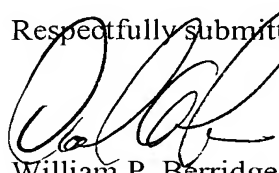
For at least this reason, any permissible combination of Tang, Geaghan and Sciammarella cannot reasonably be considered to have suggested the combinations of all of the features varyingly recited in independent claims 1 and 2.

Accordingly, reconsideration and withdrawal of the rejection of claims 1 and 2 under 35 U.S.C. §102(a) as being unpatentable over the applied references are respectfully requested.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1 and 2 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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